

1 APPEARANCES: (Continued)

2 SHAW KELLER, LLP

3 BY: DAVID M. FRY, ESQ.

4 and

5 KIRKLAND & ELLIS, LLP

6 BY: F. CHRISTOPHER MIZZO, P.C., and

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(Washington, District of Columbia)

7 Counsel for Dollar Shave Club, Inc.,
8 Dorco Company Ltd., and Pace Shave, Inc.

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23 P R O C E E D I N G S

24 (REPORTER'S NOTE: The following telephone
25 conference was held in chambers, beginning at 2:33 p.m.)

1 THE COURT: Good afternoon, counsel. This is
2 Judge Stark. Who is there, please?

3 MR. SMITH: Good afternoon, Your Honor. It's
4 Rodger Smith at Morris Nichols on behalf of the plaintiff
5 Gillette, along with Mark Abate, Michael Cottler, and
6 Jennifer Albert from Goodwin Procter.

7 THE COURT: Okay.

8 MR. FRY: Good afternoon, Your Honor. This is
9 David Fry from Shaw Keller on behalf of the defendants; and
10 with me on the line today are Christopher Mizzo and Helena
11 Kiepura from Kirkland & Ellis.

12 THE COURT: I have my court reporter here with
13 me. For the record, it is our case of The Gillette Company
14 versus Dollar Shave Club Inc., et al, Civil Action No.
15 15-1158-LPS. And this is the time we set to talk about
16 discovery-related disputes that both sides have raised. I
17 wanted to start first with the issue raised by Gillette
18 regarding the [REDACTED] blades. So let me hear from Gillette on
19 that, please.

20 MR. ABATE: Thank you, Your Honor. This is Mark
21 Abate.

22 So during discovery, before the Third Circuit
23 entered the stay in this case, we saw some passing references
24 in the documents to [REDACTED] That was concerning to us because
25 [REDACTED] was not a search term used by the defendants in the

1 collection and production of their electronic documents in
2 this case.

3 So we requested additional discovery at that
4 time, including product samples. In response, defendants
5 represented to us that [REDACTED]
6 [REDACTED] and they refused to
7 give us that discovery.

8 So then we fast forward to we have the stay in
9 place. The arbitration tribunal issues a decision, and the
10 Third Circuit lifts the stay; and we approached the defendants
11 to negotiate a new schedule, and the parties had competing
12 schedules. We submitted them to Your Honor. Your Honor
13 entered a schedule in August. As part of that, we dropped
14 some patent claims, from 21 down to seven.

15 About a week later, the defendants produce a
16 product sample. And we say what is this? They say, well,
17 this is the [REDACTED] product; and it has been imported since
18 March of 2018.

19 So this is in August. In August, then we again
20 asked for additional discovery concerning [REDACTED] At that
21 time, there was time in the schedule to deal with it, and
22 we could have dealt with it. We specifically asked for the
23 same types of discovery that we had for the other products,
24 the two other classes of products that are accused in the
25 case. We also asked for resumption of 30(b)(6) depositions

1 to be able to question about the documents; and defendants
2 refused.

3 That brings us to today. And what we propose
4 in our letter is sort of handling this one of two ways:
5 either grant our motion for a protective order to keep it
6 out of the case so that there is no issue as to estoppel or
7 negative implications, things like that, or alternatively
8 grant discovery on it; and if there is discovery granted on
9 it, we would ask for certain accommodations, which I could
10 get into, such that we can actually complete the discovery
11 in time so we can keep our current trial schedule.

12 With respect to the protective order, our
13 thinking is simply that at some point in the case, discovery
14 has to end. New products are always being introduced. This
15 case has already been delayed over a year because of our
16 trip to the arbitrators; and a protective order would just
17 guarantee that this case can go forward, we can have our
18 April trial without any further delay. Alternatively, we're
19 requesting more fulsome discovery on [REDACTED]

20 Let me address two aspects: The one is
21 discovery. And the second, why more fulsome discovery is
22 needed.

23 So in terms of the current status, the
24 production on [REDACTED] is paltry. They claim to have produced
25 [REDACTED] documents, but, Your Honor, in this case, defendants

1 have produced over [REDACTED] documents. So [REDACTED] amounts to
2 about two and-a-half percent of the production. That's
3 clearly not a commensurate production that we have for the
4 other products in the case.

5 Dollar Shave Club in particular produced a
6 single document, a fully formed 48 page report, but no other
7 documents. I mean there has got to be some other backup
8 that occurred leading up to the creation of this [REDACTED]

9 There were the product samples I mentioned and
10 also additional [REDACTED] documents produced after the stay was
11 lifted. That is, of course, after all the witnesses were
12 deposed. So we have no depositions on those documents. And
13 I think by virtue of the fact that they were produced at
14 the end of discovery, it's fair to assume that these are
15 probably very important documents that defendants would rely
16 on if [REDACTED] was in the case.

17 So how could we possibly be expected to accuse
18 the product and go to trial on it when we haven't had any
19 deposition testimony on these new documents or the new
20 product samples? How could our expert rely on any of these?
21 How could we possibly cross-examine on them? It's just not
22 feasible.

23 Now, there were some [REDACTED] documents produced
24 before the stay, that is true, but they're mostly in the
25 nature of what I would call [REDACTED] documents as opposed to

1 documents stating [REDACTED]

2 [REDACTED] And, importantly, the pre-stay
3 documents only reference work on [REDACTED] in passing, and that
4 is I think largely because the search terms didn't use the
5 term [REDACTED] We used the names of the other products in the
6 search terms.

7 There was one very technical document produced
8 before the stay on [REDACTED] We used that one at a deposition; and
9 the [REDACTED]

10 [REDACTED]
11 [REDACTED]

12 So that is the status of where we are. The
13 reason why we would request further discovery, if we're asked
14 to bring [REDACTED] into the case, is you can see in Exhibit 12 to
15 our letter brief is selected pages of our infringement
16 contentions. What you see there, there are lots of [REDACTED]
17 in the documents that go to infringement issues in the case.

18 So, for example, these are the documents in the
19 current infringement contentions, those are the documents
20 as to the two classes of products that we have accused. So
21 the documents describe those products as having, for example,

22 [REDACTED]

23 [REDACTED]

24 [REDACTED] which goes

25 to a dependent claim.

1 [REDACTED] That is Exhibit 1. In their brief, they cite page
2 816 of that exhibit.

3 One other thing. On the documents they cite
4 [REDACTED] which is documents 13 through 16, those
5 documents don't even reference [REDACTED] So there is no way I
6 can link those [REDACTED] unless I have
7 deposition testimony. So if we're going to go forward
8 with [REDACTED] in this case, in fairness, we just need additional
9 discovery, and we can talk about some accommodations I would
10 ask for in the schedule if the Court is inclined to go that
11 way.

12 But let me just turn to our motion for protective
13 order.

14 In our view, it was a little underhanded the way
15 the negotiation on the schedule was treated and the dropping
16 of claims. As I mentioned, they represented to us [REDACTED]
17 [REDACTED]
18 And then we negotiated the whole schedule -- this was over the
19 course of about two months. We're negotiating the schedule,
20 negotiating the dropped claims and dropped prior art
21 references, and at no time at all were they mentioning [REDACTED] or
22 that they wanted to bring [REDACTED] into the case. And they wait
23 until a week after we drop claims and a week after the Court
24 entered the schedule in the case to tell us about [REDACTED]

25 In our view, it's just too late to interject it

1 into the case. We're into expert discovery now. We have
2 already exchanged the burden of proof of reports, and the
3 case has been delayed a year. We just don't think we should
4 have to have the trial date pushed out because of their
5 conduct with respect to how they handled [REDACTED] and making it
6 known to us when the case resumed.

7 THE COURT: Mr. Abate, let me interrupt you with
8 just a couple quick questions before we move on.

9 MR. ABATE: Sure.

10 THE COURT: They suggest that given the claims
11 you dropped, we can tell that you wouldn't have dropped
12 different claims if you knew [REDACTED] was going to be part of
13 this case. Respond to that.

14 MR. ABATE: I can't say that for certain. We
15 have very little discovery on [REDACTED] so I can't say for
16 certain that we would not have dropped the claims that we
17 dropped if [REDACTED] were in the case.

18 Now, for example, they point to some claims that
19 had the doping limitation, but remember also there were some
20 method claims in the patent. And we dropped those as part
21 of this. There was an overall agreement we dropped those to
22 avoid certain plant discovery inspection, but had [REDACTED] been
23 in the case, perhaps we would have maintained that process
24 claim and would have gone forward with the plant inspection.

25 THE COURT: All right.

1 MR. ABATE: I cannot say categorically we would
2 have taken a different tact had we known about [REDACTED] and had
3 discovery on it because right now I don't know much about
4 that product.

5 THE COURT: Okay. Just briefly, if I don't do
6 the protective order, whatever accommodations you have in
7 mind, would they keep us on track for an April schedule, in
8 your view?

9 MR. ABATE: Well, that is what we would want to
10 do. I can tell you what they are quickly.

11 THE COURT: I don't want to get into the details
12 of them.

13 MR. ABATE: Yes.

14 THE COURT: I just want to understand if you
15 thought the trial date was still possible? It sounds like
16 you do think it is possible.

17 MR. ABATE: Yes. And the one point -- I think
18 the parties could negotiate a new schedule, but the one
19 thing we need the Court to do, you entered the dates for
20 completion of summary judgment and *Daubert* motions. You
21 entered that in one of your orders, so that is not something
22 the parties can move, so we would have to have the Court
23 move that, and we can work with the other dates to make
24 everything happen.

25 THE COURT: If I did the protective order, would

1 you envision that, meaning at trial, the world would be as
2 if [REDACTED] doesn't exist or could parties, for instance, still
3 point to it for other purposes? I don't know, if it's
4 allegedly a noninfringing alternative or something like that
5 or would it be it just doesn't exist?

6 MR. ABATE: It doesn't exist is how we would
7 handle it. And the reason why is we don't want a negative
8 inference being drawn. For example, the one you just
9 mentioned, that there is a noninfringing alternative out
10 there. I wouldn't want that to be drawn. I think in
11 fairness, you either be able to accuse it or it has to be
12 out of the case altogether.

13 THE COURT: All right. Thank you. Let me hear
14 from the defendants on this first dispute.

15 MS. KIEPURA: Your Honor, Helena Kieपुरa for
16 defendants.

17 So just at the outset, one thing that we want
18 to point out is that Pace has asserted counterclaims of
19 noninfringement in this case. This isn't really a motion
20 for a protective order, it's a motion to dismiss. Pace
21 is entitled to have the Court decide whether [REDACTED] infringes,
22 even if Gillette is arguing that it wants to drop its
23 infringement claims against it, which it appears to have
24 done given its failure to provide any sort of proof
25 whatsoever despite having discovery.

1 So moving on to the second issue. Even if it
2 was proper for them to be seeking some sort of protective
3 order, that should be denied as well because Gillette, they
4 are mischaracterizing the discovery that it had regarding
5 [REDACTED] and they had all the discovery they needed to make an
6 infringement case against [REDACTED] They just simply have chosen
7 not to do so.

8 So prior to the stay, Gillette had all the core
9 technical documents it needed to accuse [REDACTED] of infringement.

10 [REDACTED]

11 [REDACTED]

12 [REDACTED]

13 [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 They had over [REDACTED] documents. This included R&D
18 reports and testing reports. And to their point that that is
19 a smaller production than as to the other accused products,
20 that makes sense given that it is a newer product and the
21 amount of documents going back in time would be fewer given
22 that it's a newer product that was, at the time the case was
23 stayed, still not being sold in the United States, and it was
24 a new product.

25 THE COURT: All right. Let me interrupt you

1 there.

2 Can you represent that you produced the same
3 type and extent of documents for [REDACTED] as you have for the
4 other two accused blades?

5 MS. KIEPURA: As to the core technical type
6 documents? Yes, and to the extent that they existed.
7 Because, as I mentioned, the [REDACTED] product, it was not being
8 sold in the United States at the time of the stay, so there
9 were not certain types of documents, such as financial sales
10 documents, for example, showing they were sold in the United
11 States. [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

12
13
14
15 THE COURT: All right. But if I don't limit my
16 question to core technical documents, can you say that you
17 have made the same type and extent of document production
18 for the [REDACTED] as for the other two accused blades?

19 MS. KIEPURA: Mr. Abate is correct that [REDACTED] was
20 not a search term used in the searching for documents to be
21 produced because at the time, it was not a product being
22 sold in the United States. But many of the documents that
23 hit on search terms are coextensive with the documents that
24 were produced for other types of products.

25 THE COURT: Okay. But that suggests to me

1 that either we don't know how many unique documents are
2 still left to be produced if we did search for [REDACTED] or you
3 do know and it's something more than zero. Right?

4 MS. KIEPURA: Our understanding is that it
5 would be -- if we were to search for [REDACTED] it would not be a
6 significant number of additional documents that would need
7 to be produced over what has already been.

8 THE COURT: And with respect to the depositions,
9 did they have any incentive to fully explore with the
10 deponents issues related to [REDACTED] at the time that they were
11 taking the deposition?

12 MS. KIEPURA: They did. They deposed a Mr. Oh
13 whose entire job description is that he worked on the NTG
14 product, so given that they sought the deposition of the
15 specific person, they clearly had the incentive to ask him
16 questions about the [REDACTED] product.

17 THE COURT: All right. Well, first off, I guess
18 what is it that you propose on behalf of Pace? That your
19 counterclaim for noninfringement will be part of this trial
20 or summary judgment process but no further discovery should
21 be permitted? Is that the idea?

22 MS. KIEPURA: Yes, that's correct. Because
23 essentially Gillette received samples from us five weeks
24 before the close of fact discovery, eight weeks before the
25 opening expert report, and essentially they appear to have

1 just chosen not to accuse [REDACTED] despite having those samples.
2 Given that, it would not be fair to us given that we have
3 got expert reports due in about three weeks now. It would
4 not be fair to us to have to continue on given the amount
5 of discovery that Gillette already had and their failure to
6 accuse it in light of the discovery they already had.

7 THE COURT: How did the five weeks and eight
8 weeks line up when you disclosed to them that you have been
9 importing the [REDACTED] product?

10 MS. KIEPURA: It was immediate. We disclosed it
11 and provided samples immediately at five weeks was when we
12 disclosed and provided the samples, which was in line with
13 the agreement that the parties had come to regarding the
14 schedule. We sat down when the case was unsaved. We
15 negotiated a schedule, negotiated a timeline for when parties
16 were going to be providing updated discovery responses to
17 account for things that had occurred during the pendency of
18 the stay.

19 So that was five weeks when we provided the
20 sample and made the disclosure. And then eight weeks is the
21 same, eight weeks from the time, expert reports.

22 THE COURT: At the time you were negotiating the
23 schedule, and at the time they dropped some of the claims,
24 had you disclosed to them that you were importing the [REDACTED]
25 If not, why should that not weigh heavily on my decision?

1 MS. KIEPURA: The issue with regard to the
2 negotiation of the dropped claim, again, Gillette is making
3 this argument that they would have chosen different claims
4 to drop. The [REDACTED] product, as Gillette was well aware from
5 the discovery that we had already provided on it, [REDACTED]

6 [REDACTED]
7 There is a misrepresentation made during
8 Gillette's argument which is that they mention that we
9 said in our letter that the [REDACTED] That is
10 not the case. That is not what we said. The [REDACTED]

11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED] Frankly, they dropped the method claims because
17 they were trying to prevent discovery of their own
18 manufacturing process.

19 Then the other claims they dropped, which were
20 the dropped claims, as noted in briefing, [REDACTED]

21 [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 THE COURT: If I --

1 MR. ABATE: Your Honor, if I may.

2 THE COURT: Hold on.

3 MR. ABATE: I'm sorry.

4 THE COURT: If I don't grant the protective
5 order and alternatively allow additional discovery, Ms.
6 Kiepura, can we keep this trial on track for April?

7 MS. KIEPURA: Yes, absolutely.

8 THE COURT: Okay. Is there anything else you
9 want to say, Ms. Kiepura?

10 MS. KIEPURA: Not at this point, Your Honor.

11 THE COURT: Mr. Abate, briefly, you can respond.

12 MR. ABATE: Yes. So on the one point about, it
13 sounded like sort of a waiver argument that we didn't put it
14 in our expert reports, we didn't do that because the letter
15 was already before Your Honor about this issue. And in the
16 expert reports, we noted that we would supplement, if allowed.

17 On the issue about the doped claims, a very
18 interesting point Ms. Kiepura made is there is a [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED] So I cannot say, and I don't think she can say,
22 whether the doped claims would have been relevant to this
23 product or not, categorically. The fact that she says the
24 [REDACTED] means that we certainly may have
25 asserted some of those claims. As I mentioned earlier, we

1 may have asserted the method claims.

2 With the respect to the documents, [REDACTED] was not
3 a search term in the search terms string that was used. The
4 fact that other product names were used, I mean that is
5 fine. And maybe [REDACTED] gets picked up in passing, but you are
6 not going to get the [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]

10 Just at a fundamental level, I have a problem
11 with the idea that defendants are saying we're entitled to
12 tell you what documents you get; and for this product, you
13 are only getting core technical documents, and that is it.

14 That's what we get, Your Honor, when we are 90
15 to 120 days out when the case begins. That is not what
16 we're getting in discovery and it is absolutely inappropriate
17 to have my expert come out and give an infringement opinion
18 without the full scope of the materials before her.

19 THE COURT: What about the fact there is this
20 counterclaim for noninfringement? What would you have me do
21 with that?

22 MR. ABATE: Well, the counterclaim would apply
23 to the products in the case if you grant the protective
24 order. If you grant the protective order, the counterclaim
25 applies to the products in the case, and the idea would be

1 that if the parties want to bring a separate suit, one of
2 the parties on this other product, they can.

3 One thing about these other products, Your
4 Honor, it seems to be [REDACTED]

5 [REDACTED] There
6 is no guarantee that either party is going to file a new
7 case on it, but the idea would be it's out of this case
8 for this purpose, and it is not in the case for the
9 counterclaims; but if the counterclaims are a sticking
10 point, then I guess we have to go the discovery route.
11 That's okay. We'll have to work that out in the schedule;
12 and I think we have to extend the date for the final briefing.

13 The other accommodations I would ask for is
14 that the witnesses are being deposed in the U.S. rather than
15 Korea because that creates a lot more complications.

16 If they have any documents already translated
17 relating to [REDACTED] that they produce the translations.

18 The parties would work together to revise the
19 schedule. And I would suggest that we push the schedule
20 on the summary judgment back, say, four to six weeks for
21 the final briefing.

22 Also, on deposition hours, I would request
23 12 hours with Dorco's witnesses and six hours with Dollar
24 Shave witnesses. The reason why I make that request is
25 because we have 12 hours of our deposition time left in the

1 total that you gave us at the beginning of the case, so I
2 just wanted to make clear that we think we would need
3 18 hours to complete.

4 The reason why we need the extra time with Dorco
5 is just because the witnesses are deposed with a translator,
6 they speak Korean, so that takes a fair amount of time. I
7 suspect with Dorco, there would be more than one witness,
8 but with Dollar Shave only one.

9 THE COURT: Thank you. I want to give you a
10 decision on this so we have some time to go on to the other
11 dispute.

12 My decision is that [REDACTED] is part of this case, and
13 I don't think the request for discovery from the plaintiff
14 is untimely under the totality of circumstances. So you are
15 going to have to meet and confer and propose some reasonable
16 accommodations and modification to the schedule so that every-
17 one can have a full and fair opportunity to take discovery and
18 serve expert reports and take depositions and litigate whether
19 [REDACTED] in fact, infringes or not.

20 I think under the circumstances, it's clear to
21 me that plaintiff has reasonably relied on what it was told
22 by the defendants which before this day was essentially that
23 [REDACTED] and after the stay was lifted but
24 only after the schedule had been negotiated and, notably,
25 only after the plaintiff dropped some of its claims, as they

1 were required here to do, only then was the plaintiff told
2 about [REDACTED]

3 So I find from what I am understanding that
4 the plaintiffs have not received a production of documents
5 commensurate to the production for the other two accused
6 products, they have not received that for the [REDACTED] They
7 did not have the motivation or incentive to explore in
8 deposition or, frankly, the ability to fully explore in
9 deposition issues related to [REDACTED] because they didn't have
10 the documents, and they're entitled to all that.

11 Now, I think on the whole, it's better that we
12 not enter a protective order and in part create a fiction
13 that the [REDACTED] doesn't exist. You always have to be concerned
14 about how that could cause bigger problems at trial when we
15 have to basically tell witnesses, pretend that [REDACTED] doesn't
16 exist.

17 Further, I think there is time in the schedule
18 between now and April, because I'm not moving the trial
19 date, to have everyone be fully and fairly heard and take the
20 necessary discovery to deal with the [REDACTED] Plus, there would
21 be the issue about what to do with the counterclaim, were I
22 to entertain the protective order.

23 I'm not ruling on the accommodations that
24 Mr. Abate has mentioned. I want the parties to meet and
25 confer on those. I can say on first pass they all sounded

1 reasonable to me, but that is not an order. I have not
2 heard from the defendants on those.

3 As you all try to figure out how to modify the
4 schedule, I am definitely willing to give you more time for
5 getting the briefing in on the dispositive and the *Daubert*
6 motions. I'll need at least a couple of weeks before any
7 hearing for the briefing to be completed, but I am willing
8 to move quickly in order to make this all happen.

9 So you all meet and confer. I hope you can work
10 out a schedule. If you can't, then let's say by Wednesday,
11 get me a joint letter with your disputes, and I will try to
12 resolve them as soon as I can.

13 Are there any questions about that, Mr. Abate?

14 MR. ABATE: No, Your Honor. Thank you.

15 THE COURT: And Ms. Kiepura, any questions?

16 MS. KIEPURA: No, Your Honor.

17 THE COURT: Let's move on in our remaining time
18 to the issue raised by defendants. The request for an
19 order to produce more documents related to the infringement
20 contentions.

21 Let me hear from defendants first, please.

22 MR. MIZZO: Good afternoon, Your Honor. Chris
23 Mizzo from Kirkland representing the defendants.

24 Yes. By way of background, in October 2017,
25 defendants moved to compel production of documents that form

1 the basis of Gillette's infringement contentions because
2 those contentions relied on select images and results from
3 tests of the accused products.

4 When Gillette refused to produce documents
5 regarding those tests, we moved for relief. The case was
6 stayed, but after the stay was removed, the Court issued
7 its order on July 23, 2018 granting defendants' motion to
8 compel.

9 The Court found that under the circumstances,
10 Gillette waived any potential privilege or protection that
11 they may want to apply to disclosed images, and that would
12 not further the interest of fairness or efficiency to make
13 defendants wait for expert discovery to learn Gillette is
14 relying on the images and only thereafter be in a position
15 to analyze and potentially take discovery of them.

16 So based on that order, on August 3rd, 2018,
17 Gillette made a partial production of testing documents,
18 but that production is deficient with notable gaps in the
19 production.

20 Further, defendants sought additional limited
21 deposition testimony by way of a 30(b)(6) notice of Gillette,
22 and Gillette refused to produce any additional deposition
23 testimony, or any deposition testimony on those tests.

24 So that leaves us or brought us to then file
25 this motion. As part of this motion, we seek three different

1 types of materials, Your Honor:

2 The first are materials related to tests of
3 accused products not expressly cited in the infringement
4 contentions.

5 The second set of materials are materials
6 related to tests expressly cited in the infringement
7 contentions.

8 Then the third is a Gillette corporate witness
9 for deposition.

10 Taking them in turn, beginning with materials
11 related to tests of accused products not expressly cited in
12 the infringement contentions.

13 Gillette has admitted that it limited its
14 production in response to the Court's July 23rd order to
15 "cited tests." It does not dispute there are tests of the
16 same accused products that it has withheld.

17 Defendant's original motion wasn't limited to
18 what was cited in the infringement contentions. Rather,
19 they sought the materials that formed the basis for those
20 contentions which is broader.

21 We believe the plain language of that, which Your
22 Honor quoted in the decision that formed the basis, includes
23 not only what was expressly cited in their infringement
24 contentions but all of the tests that Gillette considered when
25 shaping its infringement narrative. For example, if Gillette

1 tested a type of razor called the 4X, and it tested it ten
2 times and nine of those gave terrible results and one was less
3 terrible, and they decided to cite that less terrible result,
4 we believe that all ten form the basis for the contention and
5 should be produced. Thus, we believe that Gillette should be
6 ordered to produce all the tests and related materials
7 concerning the accused products whether or not expressly cited
8 in the contentions.

9 Now, in their opposition, Gillette refers to
10 uncited testing in a time that seems to suggest that what
11 we're seeking is information related to unaccused blades.

12 To be clear, Your Honor, we are not seeking
13 production of testing related materials for unaccused products.
14 This request is simply for the products that have been accused
15 for which they did submit tests, and it's stuff they would
16 have considered when formulating their infringement contentions.

17 On to the second category of documents or
18 materials. Materials related to tests that are expressly
19 cited in the infringement contentions.

20 Gillette contends in its opposition that it has
21 complied with the Court's Order, but it did not do so. Its
22 production remains deficient. There are types of documents
23 that we would expect to see that relate to the test expressly
24 cited that they have not produced.

25 For example, inspections given to their

1 third-party testing company, EAG, whether correspondence or
2 otherwise. They haven't produced any instructions. We would
3 expect those instructions, for example, to include the types
4 of tests and the scope requested, the locations, the tests
5 for each sample, including which locations might be relied
6 upon. Who ordered the test to be done? The directions for
7 sample preparation, and so on.

8 There is also, it's also clear based on the
9 documents that they produced that EAG has a job folder for
10 the different tests that it conducts. Those job folders may
11 have but we don't know because they haven't been produced,
12 but we guestimate that the job folders would hold things
13 like analytical protocols, analysis locations, results,
14 interpretation results. They haven't produced those. They
15 have only produced reports, finished reports.

16 In that regard, we also haven't seen any raw
17 data or raw images. We haven't seen things that were not
18 included in the reports that were taken of the exact accused
19 products that are included in their infringement contention.

20 So, for example, if they took images of the
21 same blade from different magnification, and they weren't
22 included in the document that they produced, even though
23 it's from the same exact test, they haven't produced them.

24 They haven't produced verifications regarding
25 calibration of the equipment or dates when any of this stuff

1 was done. So there is a lot of material that we would expect
2 to see there for the tests that even they expressly cite in
3 their infringement contentions and we have not seen in their
4 production. That is the second category of materials that we
5 are seeking to compel disclosure of.

6 The third request, Your Honor, concerned a
7 Gillette corporate witness. Now, Gillette admits it has
8 refused to provide a 30(b)(6) deposition on the testing
9 that is taking place; its primary argument that a deposition
10 of Gillette would be wasteful because really EAG, that third
11 party, has the information that we want.

12 But Gillette is mistaken. And even if EAG has
13 that information or knows that information, that does not
14 allow Gillette or shouldn't allow it to dodge a deposition.

15 First, there is no dispute that the information
16 that is being sought is relevant, and that deposition
17 testimony is appropriate.

18 Second, there is no dispute that Gillette has
19 or should have some information responsive to the topics
20 served on Gillette. In fact, based on Gillette's working
21 relationship with EAG and greater familiarity with the
22 tests done by EAG, we believe that Gillette played a role
23 in the tests done by EAG that led to the tests cited and
24 that form the basis of their infringement contentions. And
25 we believe we should be allowed to explore that role and

1 the facts regarding those tests as part of the deposition.

2 THE COURT: All right.

3 MR. MIZZO: That way --

4 THE COURT: All right. Mr. Mizzo, right, we're
5 starting to run out of time.

6 So with respect to EAG in this request, are you
7 asking me to order something directly from EAG or you are
8 only looking for whatever you can get from Gillette?

9 MR. MIZZO: Your Honor, the parties have agreed
10 that EAG is going to sit for a deposition. This particular
11 motion that is before you concerns the scope of discovery
12 that we're going to obtain from Gillette which will also
13 inform the scope of discovery that we would get from EAG.

14 So, for example, if Your Honor rules that they
15 have withheld the materials and should produce the materials
16 that concerns tests of the accused products that are not
17 expressly cited, then that would also be testimony that EAG
18 would provide on those tests that were done.

19 However, the motion that is before you, Your
20 Honor, concerns compelling discovery from Gillette and
21 concerning the tests.

22 THE COURT: Okay. And if I don't agree with
23 your interpretation of the earlier motion and order, do you
24 have an argument that I should nonetheless grant the relief
25 that you are seeking today?

1 MR. MIZZO: I guess the question -- I guess
2 it's difficult, Your Honor, because I'm not sure, when you
3 say that you may not -- if you do not agree, what would that
4 disagreement be, because I'm in a situation right now where
5 their expert cites this testing that was done by Gillette.

6 They said that this testing was directed by
7 counsel, not by a testifying expert. That is why they moved
8 in front of you and said they should be protected because it
9 has nothing to do with their testifying expert.

10 It turns out the testifying expert relies on the
11 testing that has now been done. We believe it is appropriate
12 under the Court's order, and we believe that the appropriate
13 order, the scope of it would concern not only what was
14 expressly cited but what form the basis for those contentions.

15 So I guess it would be depending on how you
16 disagree with our reading of the order as to how I would
17 respond, but I believe that the scope encompassing test of
18 accused products is appropriate. And I believe that their
19 withholding of additional materials related to even the
20 stuff that they have disclosed is also inappropriate under
21 the Court's order.

22 THE COURT: Okay. Thank you.

23 Let me hear from plaintiff, please.

24 MR. COTTLER: Good afternoon, Your Honor. This
25 is Michael Cottler from Goodwin Procter.

1 So let me address the first issue, which is what
2 does the Court's prior order require? That is D.I. 564.
3 That, of course, is the question that the parties presented
4 to Your Honor. It was not whether there was waiver over
5 tests that Gillette did not cite in its contentions.

6 Gillette's response to defendants' letter
7 directly answered that question; and in stark contrast,
8 defendant's letter pretty much danced around it.

9 Going back to Docket No. 526, that was the
10 parties' joint letter to the Court that had the parties ask
11 the Court to set briefing on this issue. And the issue was
12 Gillette's refusal to produce documents related to its
13 testing of defendants' products relied upon by Gillette in
14 its infringement contentions.

15 It is pretty clear that the parties were looking
16 to address whether they should have to produce the documents
17 relating to those tests that Gillette relied upon in its
18 contentions and nothing more.

19 The defendants' opening motion was consistent
20 with that. They said that Gillette should have to produce
21 the documents that form the basis for its contention. And
22 nowhere in their letter do they ever talk about tests that
23 Gillette never relied upon. In fact, the whole point of
24 defendants' letter, the harm they alleged was they didn't
25 know how Gillette performed the testing that allegedly shows

1 infringement.

2 Now, Your Honor, once the defendants got that
3 discovery from Gillette, they said, oh, we want more. Now
4 they want all the tests from July 6th. That wasn't what
5 they asked for.

6 THE COURT: Mr. Cottler, let's start there then.
7 Why shouldn't I give them that at this point? I mean I
8 have the same concern Mr. Mizzo raised. What if you all
9 did ten tests and nine out of ten were not consistent with
10 infringement? Shouldn't the defendant know that at this
11 point in the case?

12 MR. COTTLER: With respect, no, Your Honor. So
13 the testing done by a nontestifying expert, here EAG, is
14 protected under Rule 26(b)(4)(D), and that was formerly
15 (b)(4)(D). In our response, Your Honor, Gillette cited
16 the *Holinger* case, which addresses the protection covered
17 by 26(b)(4)(D), and that governs discovery of facts known
18 and obtained, held by experts and acquired or developed in
19 anticipation of litigation or for trial.

20 The Court there explains that this rule forbids
21 discovery of the facts found or the opinions formulated by
22 an opponent nontestifying expert with the exception of
23 certain exceptional circumstances, which defendants have not
24 shown here.

25 The Court further noted that while the rule

1 itself does not address waiver, it identified that courts
2 have generally held that partial disclosure of a
3 nontestifying expert's work product does not waive rights
4 to withhold undisclosed work product. That is at page 522
5 of the decision, and it goes on to cite several examples
6 of such cases, including ones from Delaware and New York.

7 At issue in *Holinger* was a report prepared by a
8 non-testifying expert from which particular portions were
9 disclosed in what I will call a committee report. The
10 opposing side wanted the entirety of that report produced,
11 arguing that producing part of it waived protection over
12 the entirety of it. And the Court disagreed, holding that
13 the disclosure of certain findings from the report did not
14 automatically forfeit protection as to withheld information
15 or place the entirety of the work at issue.

16 THE COURT: All right. Mr. Cottler, we're
17 getting short on time.

18 MR. COTTLER: Sure.

19 THE COURT: So what about here, Dr. Ross
20 apparently has told us now that she is the one that ordered
21 the tests, and she is the one who relies on them in her
22 infringement analysis. Doesn't that create a different
23 situation here?

24 MR. COTTLER: No, Your Honor. It does not.

25 To start, Rule 26 also governs the discovery

1 that must be produced with an expert testifying report, and
2 the rule requires that Dr. Ross produce all the materials
3 that she consider, and Dr. Ross has done so, and any test
4 reports from EAG that she considered were produced.

5 Now, Dr. Ross did dictate the protocol that
6 was employed by EAG to carry out the tests that are cited
7 in Gillette's contentions. It was ultimately its law firm
8 that hired EAG as a nontestifying expert. So defendants,
9 in their opening letter, try to make hay out of the fact
10 that, well, Gillette said on the one hand that Gillette
11 retained EAG. Now they're saying that Dr. Ross hired EAG or
12 something to that effect. But the reality is that Gillette
13 had to give the go ahead to EAG, or its counsel did, to do
14 its testing, and EAG used its protocol that Dr. Ross provided.
15 And to the extent she relied on or considered any testing by
16 EAG, those were produced.

17 THE COURT: And so help me understand what you
18 mean by "relied or considered." Do the defendants -- yes.
19 Do the defendants have all of the test results that she has
20 seen throughout this case?

21 MR. COTTLER: Yes, Your Honor.

22 THE COURT: Did they have all the test results
23 that EAG conducted?

24 MR. COTTLER: Pardon me, Your Honor?

25 THE COURT: Let me put it this way: Has Dr.

1 Ross seen all of the test results that EAG produced?

2 MR. COTTLER: Yes. So produced to defendants,
3 Your Honor?

4 THE COURT: If EAG did ten tests, did all ten go
5 to Dr. Ross or did somebody in between Dr. Ross and EAG say
6 which of the ten were going to go to Dr. Ross?

7 MR. COTTLER: Hold on one moment, Your Honor.

8 THE COURT: Sure.

9 (Pause.)

10 MR. COTTLER: I apologize, Your Honor.

11 There may have been some tests that Dr. Ross did
12 not see, including some unaccused products. But one point
13 I want to make is as a matter of fairness, defendants now
14 have the complete testing that Dr. Ross considered and that
15 Gillette relied on in its infringement contentions, including
16 a protocol for how those tests were carried out. Defendants
17 are capable of hiring an expert, if they hadn't already, and
18 duplicating that protocol and comparing the results of their
19 testing with the results that Gillette relied upon in its
20 infringement contentions, and that Dr. Ross considered in her
21 expert report.

22 THE COURT: Well, putting aside the non-accused
23 products, I guess what this seems to be maybe turning on is
24 are we all talking about the same thing when we say what
25 Gillette, in its infringement contentions, or what Dr. Ross,

1 in her report, considered, formed the basis for and/or relied
2 on? Do you see a distinction among those three things:
3 considered, formed the basis, or rely?

4 MR. COTTLER: Sitting here today, Your Honor, I
5 don't think I see a distinction. I know that the federal
6 rules have changed a bit and maybe -- and I know it now says
7 "materials considered," at one point maybe it said "relied."
8 In my mind, it's all pretty similar.

9 THE COURT: And under any of those three,
10 again, your representation is at least every test result
11 that Dr. Ross has been exposed to with respect to the
12 accused products has been provided to the defendants; is
13 that right?

14 MR. COTTLER: That's correct, Your Honor.

15 THE COURT: But if I ask the same question
16 about when Gillette prepared its infringement contentions
17 that was the subject of the earlier order, it sounds like
18 even if I am limiting it to accused products, you are not
19 in a position to say that every test result that Gillette
20 had had been provided to the defendants; is that right?

21 MR. COTTLER: By "Gillette," you are referring
22 to Gillette's counsel?

23 THE COURT: Yes, as a representative of
24 Gillette. Yes.

25 MR. COTTLER: There may have been such tests,

1 that's correct. By EAG.

2 THE COURT: Is there anything else you want to
3 add, Mr. Cottler?

4 MR. COTTLER: Yes. To answer that question,
5 Your Honor, I think I made my point. Now I can move on to
6 the 30(b)(6) issue?

7 THE COURT: Yes, just briefly, please.

8 MR. COTTLER: Briefly. Okay. Well, briefly, I
9 think that the Court should quash defendants' 436 notice of
10 Gillette. As we represented to defendants, Gillette has
11 no direct knowledge about the testing that EAG did.

12 EAG, in response to a subpoena from defendants,
13 has agreed to be deposed, and so defendants look at that
14 discovery from EAG. Any deposition of Gillette will be
15 unreasonably cumulative; and Rule 26(b)(2)(C) gives the
16 Court power to limit discovery if the discovery sought is
17 unreasonably cumulative.

18 Parties hire experts all the time to do testing
19 for trial, and those parties are never required to provide
20 30(b)(6) testimony regarding the substance of the expert's
21 testing or opinion, nor should they have to because they
22 won't have direct knowledge of that information.

23 While Gillette does have access to some of the
24 files that EAG has that was the result of Gillette paying
25 the bills, that does not make Gillette an agent of EAG, and

1 so Gillette does not have to be knowledgeable about
2 everything that EAG has knowledge about.

3 THE COURT: Is Gillette going to interpose
4 any objection to EAG disclosing to defendants all the test
5 results that EAG provided to Gillette?

6 MR. COTTLER: It would be the same amount of
7 objection, Your Honor, the same Rule 26(b)(4)(D) protection.

8 THE COURT: Right. Meaning, yes, you do object
9 to EAG providing this testimony and evidence; right?

10 MR. COTTLER: Yes, Your Honor.

11 THE COURT: All right. Thank you.

12 Mr. Mizzo, is there anything you want to respond
13 to?

14 MR. MIZZO: Yes, Your Honor. I think the e-mail
15 hit the nail on the head because we have learned that Dr.
16 Ross conveyed a protocol to EAG. EAG used that to conduct a
17 number of tests of the accused products. And then there has
18 been cherrypicking for the infringement contentions that
19 have been provided as well as what was shown to Dr. Ross.

20 We believe that when we sought what was the
21 relief regarding the infringement contentions, this is
22 before Dr. Ross had been identified as a testifying expert
23 on infringement, we did seek the results and the tests that
24 form the basis for the contentions, now this is made even
25 more prejudicial by the fact that Dr. Ross was relying on

1 some subset of tests based on the testing protocol given by
2 the third-party testing agency. So for the reasons I stated
3 in the past, we would request enforcement of the Court's
4 July 23 order.

5 With regard to the 30(b)(6) deposition, again,
6 they haven't represented and nor would now be the time, that
7 Gillette doesn't have any personal information regarding
8 it, which is what I think they would need to do in order to
9 say it wouldn't be appropriate to have a Gillette witness
10 testify.

11 Their argument is simply that EAG has more
12 information where we will take the deposition of EAG. If
13 they want to designate EAG as a 30(b)(6) deposition or a
14 witness, they are allowed to under the rules, but if they
15 choose not to, then that is a choice of their own making,
16 not of defendant.

17 So for those reasons, we would request that the
18 Court grant our motion.

19 THE COURT: All right. I'm granting the
20 defendants' motion. I think that that is consistent with,
21 if not directly ordered by, the earlier order that I entered
22 that we have been discussing.

23 I think whether you say produce the tests that
24 EAG or Dr. Ross or Gillette considered or formed the basis
25 for the contentions on which they relied, I think that all

1 of this was within the scope of what was at stake in
2 connection with the prior motion.

3 We have now learned. What we have learned since
4 I think only strengthens the basis of that ruling. That is,
5 we have now learned that Dr. Ross is the one who set out the
6 protocol for the tests. We learned that she is also the
7 testifying expert in this case. To the extent it would be
8 required, I think there is good cause to modify and expand
9 the earlier offer so as to avoid a situation where under
10 the totality of the circumstances here, it could be that
11 numerous tests were done according to that same protocol and
12 came up with materially different results, and that someone
13 is somehow keeping those results from the very expert who
14 designed the test protocol and is going to be testifying
15 ultimately in front of a jury and opining as to infringement.

16 That does not seem consistent with the purposes
17 of the whole process of discovery and trial that we're all
18 engaged in under the circumstances here.

19 It follows that a deposition of Gillette is not
20 cumulative or otherwise unduly burdensome. Therefore, I
21 order that that deposition go forward as well.

22 So the ruling is for the defendants.

23 We're already past the time I had set for the
24 call. But any questions about any of that, Mr. Mizzo?

25 MR. MIZZO: No, Your Honor. Thank you for your

1 time.

2 THE COURT: Mr. Cottler?

3 MR. COTTLER: No, Your Honor. Thank you.

4 THE COURT: Thank you all very much. Good-bye.

5 (Telephone conference 3:18 p.m.)

6

7 I hereby certify the foregoing is a true and accurate
8 transcript from my stenographic notes in the proceeding.

8

9 /s/ Brian P. Gaffigan
10 Official Court Reporter
U.S. District Court

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